

### **Remarks**

Claims 1-29 are pending in the application. Claims 30-33 have been canceled. New claims 34-36 are added herein. The Applicant thanks the Examiner for the courtesies extended to Applicant's representative in the telephonic interview held May 12, 2006. No agreement was reached in the interview regarding the patentability of the pending claims or the propriety of the claim rejections in view of the cited references.

Independent Claim 1 and depending claims 2 and 5-7 stand rejected under 35 USC 102(a) as being anticipated by published U.S. Patent Application No. 10/078,031 by **Leist** et al. (Pub. No. 2002/0179255). Independent Claims 1, 8, 22, and 27 and dependent claims 2-7, 9-21, 23-26, and 28-29 stand rejected under 35 USC 103(a) as being unpatentable over **Leist** in view of U.S. Pat. No. 6,446,695 to **Forsland**. The Applicant respectfully traverses the rejections of claims 1-29, and presents new claims 34-36 for examination.

#### **I. Claims 1, 2 and 5-7 are Novel Over Leist et al.**

Independent Claim 1 and depending claims 2 and 5-7 stand rejected under 35 USC 102(b) as being anticipated by published U.S. Patent Application No. 10/078,031 by **Leist** et al. (Pub. No. 2002/0179255). In order for a claim to be anticipated by a reference under 35 USC 102(b), the reference must disclose every limitation recited in the claim.

Independent Claim 1 has been amended. Claim 1 and depending claims 2 and 5-7 each recite an "overhead garage door consisting essentially of three rectangular garage door sections, the sections being pivotally connected together one above the other, at least two of the door sections each including at least one thin-walled face panel and one or more rectangular patterns embossed in the face panel, wherein each of the rectangular embossed patterns in the face panels is taller than it is wide, and the embossed patterns cooperate to provide the garage door with the simulated appearance of at least two separate, cooperating swinging doors when the garage door is in a closed position." (emphasis added) **Leist** does not describe such a door structure. Indeed, **Leist** describes a substantially conventional sectional overhead door having a combined

weather seal and wear insert between adjacent door sections. **Leist** does not disclose a door having only three door sections, or at least two door sections that include thin-walled face panels with rectangular embossed patterns in the face panels that are taller than they are wide and that combine to provide the door with the simulated appearance of at least two swinging doors as recited in the claims. To the contrary, as shown in Fig. 1 of **Leist**, **Leist** describes a substantially conventional sectional overhead door having four door panel sections (14) with rectangular patterns that are substantially wider than they are tall. In addition, **Leist** fails to disclose a garage door with the simulated appearance of at least two separate, cooperating swinging doors when the garage door is in a closed position as required by Claim 1. Because **Leist** does not disclose every limitation recited in any one of claims 1, 2 and 5-7, the rejection of claims 1, 2 and 5-7 under 35 USC 102(a) should be withdrawn.

## **II. Claims 1-29 are Patentable Over Leist et al. in View of Forsland**

### **a. The Examiner has the Burden to Establish a Prima Facie Case of Obviousness**

The Examiner has the burden to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103(a). See MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. See MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.* (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

**b. The Office Action Does Not Set Forth a Prima Facie Case of Obviousness**

Claims 1-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Leist** et al. in view of U.S. Pat. No. 6,446,695 to **Forsland**. Specifically, the Office Action states that **Forsland** discloses a multi-paneled garage door which simulates double doors, and that it would have been obvious to modify **Leist** to provide the overhead door with the appearance of the **Forsland** doors. The Office Action further states that though **Leist** does not simulate typical doors as presently disclosed, **Forsland** is clearly concerned with decorative appearances.

**i. Claims 1-7**

Independent Claim 1 (and each of depending claims 2-7) recites an overhead garage door that includes three rectangular garage door sections. Neither **Leist** nor **Forsland** describe an overhead door that includes three door sections. As explained in the Declaration of Loren D. Mock (hereinafter the “Mock Decl.”) filed concurrently herewith, producing an overhead sectional door with only three panel sections creates special problems. (See Mock Decl. ¶ \_\_) Accordingly, it would not have been obvious to a person of ordinary skill in the art to modify the four panel doors of **Leist** or **Forsland** (or any other prior art door with four or more sections) to include only three sections. (See Mock Decl. ¶ \_\_) Accordingly, the combination of references does not teach or suggest all the claim limitations, and the rejection of claims 1-7 under 103(a) should be withdrawn.

In addition, Claim 1 (and each of depending claims 2-7) further recites at least two door sections that each include a thin-walled face panel and one or more rectangular patterns embossed in the face panel that are taller than they are wide. As explained in the Mock Declaration, these upright rectangular embossed patterns in the face panels cooperate to at least partially provide the garage door with the simulated appearance of at least two separate, upright swinging doors when the garage door closed. (See Mock Decl. ¶ \_\_) Neither **Leist** nor **Forsland** disclose a rectangular embossed pattern in a thin-walled face panel that is taller than it is wide. Accordingly, the combination of references does not teach or suggest all the claim limitations, and the rejection of claims 1-7 under 103(a) should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification. Indeed, there is no teaching or suggestion in either reference to modify the metal overhead door of **Leist** in view of the wooden door of **Forsland**. The plural-door facade of **Forsland** is formed by affixing thick wooden members to the outer faces of thick-walled, non-metal door panels, and does not achieve a plural door appearance by virtue of any arrangement of patterns embossed in a thin-walled face panel as claimed. Moreover, **Leist** is completely unconcerned with simulating the appearance of anything other than a conventional overhead sectional door. A person of ordinary skill in the art at the time of the invention would understand that the rectangular patterns of **Leist** are intended to break up the expansive outer surface of the metal door, and not to simulate two or more swinging doors. In an obviousness rejection under 35 USC 103(a), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 1-7 under 35 USC 103(a) should be withdrawn.

Furthermore, as explained in detail below, the Mock Declaration presents substantial objective evidence of the non-obviousness of the invention recited in Claims 1-7, including long-felt need, commercial success and industry acclaim, and prompt copying or nearly simultaneous invention by competitors. Accordingly, the rejection of claims 1-7 under 35 USC 103(a) should be withdrawn.

#### **ii. Claims 8-21**

Independent claim 8 has been amended. Claim 8 (and each of depending claims 9-21) recites an overhead garage door comprising a substantially rectangular upper and lower sections including thin-walled face panels having a front face, an upper edge, a lower edge, and side edges. The front faces each include integrally-formed substantially vertical grooves that substantially extend between the upper and lower edges. At least one connector pivotally connects the bottom edge of the upper section to the top edge of the lower section, and the front faces of the sections are substantially coplanar when the garage door is in a closed position. The

substantially vertical grooves are substantially collinear when the garage door is in the closed position, thereby substantially simulating the appearance of a vertical separation between left and right portions of the upper and lower sections. Opposed portions of the upper and lower sections on either side of the first and second substantially vertical grooves are bilaterally symmetric with each other. Neither **Leist** nor **Forsland** discloses upper and lower door sections having such cooperating integrally-formed substantially vertical grooves. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Leist**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 8-21 under 35 USC 103(a) should be withdrawn.

Furthermore, as explained in detail below, the Mock Declaration presents substantial objective evidence of the non-obviousness of the invention recited in Claims 8-21, including long-felt need, commercial success and industry acclaim, and prompt copying or nearly simultaneous invention by competitors. Accordingly, the rejection of claims 8-21 under 35 USC 103(a) should be withdrawn.

### **iii. Claims 22-26**

Independent claim 22 has been amended. Claim 22 (and each of depending claims 23-26) recites an overhead garage door comprising an embossed pattern in a thin-walled face panel, the embossed pattern comprising an integrally-formed panel portion, the panel portion having a substantially planar portion including a plurality of spaced, parallel vertical grooves. The planar portion substantially simulates the appearance of a non-metal panel formed by a plurality of assembled tongue-and-groove planks, is substantially rectangular in shape, and has a height that is greater than its width. Neither **Leist** nor **Forsland** discloses an embossed thin-walled door panel having an integrally-formed panel portion with a substantially planar portion that includes a plurality of spaced, parallel vertical grooves, and has substantially rectangular in shape with a height that is greater than its width. In an obviousness rejection under 35 USC 103(a), the prior

art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Leist**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 22-26 under 35 USC 103(a) should be withdrawn.

Furthermore, as explained in detail below, the Mock Declaration presents substantial objective evidence of the non-obviousness of the invention recited in Claims 22-26, including long-felt need, commercial success and industry acclaim, and prompt copying or nearly simultaneous invention by competitors. Accordingly, the rejection of claims 22-26 under 35 USC 103(a) should be withdrawn.

#### *iv. Claims 27-29*

Independent claim 27 (and each of depending claims 28 and 29) recites an overhead garage door having an integrally embossed pattern in a thin-walled face. The embossed pattern includes an integrally-formed panel portion having a rectangular frame portion bordering top, bottom, and side margins of the raised panel. A recessed substantially planar panel portion is disposed within the rectangular frame portion, and at least one integrally-formed, diagonally-oriented, simulated support member is disposed within the frame portion of the panel. Neither **Leist** nor **Forsland** discloses an integrally-formed, diagonally-oriented, simulated support member disposed within the frame portion of an embossed panel. Indeed, neither **Leist** nor **Forsland** disclose a diagonal support member of any type. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Leist**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 27-29 under 35 USC 103(a) should be withdrawn.

Furthermore, as explained in detail below, the Mock Declaration presents substantial objective evidence of the non-obviousness of the invention recited in Claims 27-29, including long-felt need, commercial success and industry acclaim, and prompt copying or nearly simultaneous invention by competitors. Accordingly, the rejection of claims 27-29 under 35 USC 103(a) should be withdrawn.

For these reasons, a *prima facie* case of obviousness has not been established, and the rejections of claims 1-29 under 35 USC §103(a) should be withdrawn.

**c. There is Substantial Objective Evidence of Non-Obviousness**

The Mock Declaration file herewith pursuant to 37 CFR 1.132 presents substantial objective evidence of non-obviousness of claims 1-29. The Supreme Court affirmed the utility of such secondary considerations in determining whether an invention is obvious under 35 USC 103 in *Graham v John Deere Co.*, 383 US. 1, 148 USPQ 459 (1966). *See* MPEP 716.01(a). Such evidence can include:

- i. Evidence that the Invention Satisfies a Long-Felt Need** (*see, e.g., In re Mahurkar*, 831 F. Supp. 1354, 1377-78, 28 USPQ2d 1801, 1819 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 USPQ2d 1138 (Fed. Cir. 1995) (stating, “The existence of an enduring, unmet need is strong evidence that the invention is novel, not obvious, and not anticipated”));
- ii. Evidence of the Commercial Success of the Invention** (*see, e.g., In re Hayes Microcomputer Products Inc.*, 982 F.2d 1527, 1540, 25 USPQ2d 1241, 1251 (Fed. Cir. 1992);
- ii. Evidence of Professional Approval of the Invention** (*see, e.g., Vulcan Engineering Co., Inc. v Fata Aluminum, Inc.*, 278 F.3d 1366, 1373, 61 USPQ2d 1545 (Fed. Cir. 2002), *cert. denied*, 123 S. Ct. 81 (2002)); and


iv. **Evidence of Prompt Copying of the Invention by Competitors** (*see, e.g., Advanced Display Systems, Inc. v Kent State Univ.*, 212 F.3d 1272, 54 USPQ2d 1673 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 904 (2000)).

The Applicant requests that the Examiner carefully consider the objective evidence of nonobviousness presented in the Mock Declaration as the evidence relates to rejected claims 1-29.

### **Conclusion**

The Applicant believes that claims 1-29 and 34-36 are in condition for immediate allowance, and such action is respectfully requested. If any issue remains unresolved, Applicant's attorney welcomes a telephone call from the Examiner to expedite allowance of the claims.

Respectfully submitted,

  
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